

REMARKS

Provisional Double Patenting Rejection:

The Examiner has rejected claim 1 as being provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending application 10/059,049. Applicant respectfully asserts that the Examiner's rejection of claim 1 is improper and kindly requests the Examiner to withdraw the rejection. Having made no other rejection in the application, Applicant kindly requests the Examiner to withdraw the rejection and permit the application to issue as required by the M.P.E.P section 804, page 19:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the **only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application issue as a patent...**

When there are no other rejections in an application, the Examiner should withdraw the rejection in the instant application and make a double patenting rejection in other application.

The Applicant also requests the Examiner to withdraw the rejection because in addition to being improper, the Examiner has not made a *prima facie* case of obviousness. The Examiner has merely alleged that "It would have been obvious... to omit the additional elements of claim 1 to arrive at [claim] 1 of the instant application because the person would have realized that the remaining [elements] would perform the same functions as before." The M.P.E.P. section 804, requires for an obvious type double patenting rejection:

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obvious-type" nonstatutory double patenting rejection may be appropriate.

A double patenting rejection of the obvious-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In *re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In *re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In *re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis.

These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obvious-type double patenting is made in light of these factual determinations.

Any obvious-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.


The M.P.E.P. plainly requires the Examiner to make a *prima facie* case of obviousness in based on the Graham factors set forth above. Claim 1 of the instant application and claim 1 of 10/059,049 are patentably distinct. Claim 1 of the instant application requires, *inter alia*, the step of "connecting a local processing adapter to the data communication network at a user location, the local processing adapter performing steps of: enabling a user to establish a user record, and enabling a user to establish a subscription record." There is no step in Claim 1 of the 10/059,049 Application that renders this step obvious. Applicant respectfully asserts that Claim 1 of the instant application is not obvious in view of the copending application, because the Examiner has

not set forth substantial evidence of obviousness based on the four Graham factors to make a *prima facie* case of obviousness as required by M.P.E.P. section 804.

CONCLUSION

Applicant has attached pages 19 and 22 of section 804 for the convenience of the Examiner. In view of the foregoing remarks, it is believed that the claims in this application are in condition for allowance. Early and favorable reconsideration is respectfully requested.

Respectfully submitted,
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